

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the following remarks.

Invention

The present Invention is directed to a process wherein the toner is formed by coagulating a crystalline ester compound of formula 1 and a resin particle in an aqueous medium in the presence of an aluminum compound. The crystalline ester compound acts as a mold-releasing agent.

One of the novel aspects of the invention is that the crystalline ester compound is uniformly included in the toner particle.

Specification Amendments

In the Office Action, the Examiner requested that the Specification be reviewed for possible minor errors. The Specification has been reviewed and typographical errors have

been corrected herein to the Specification. No new matter has been added by way of these amendments.

Claim Status

Claims 1-21 are presented for further prosecution. Claim 1 has been amended to more particularly set forth that which Applicants consider to be their invention. Support for the amendment to claim 1 can be found, for example, on page 6, lines 6-7.

The Examiner proposed amending the claims by stating the aluminum compound acts as a coagulation agent which is subsequently removed by washing. Applicants decline to make such an amendment and submit that the claims, as presented, do not cite that all of the coagulating agent is removed, albeit, that washing does reduce the amount of coagulation agent in the toner.

Prior Art Rejection

Claims 1-21 have been rejected as being unpatentable over a combination of Tan (U.S. 5,066,560), Matsushima (U.S. 6,602,644), Hagi (U.S. 5,976,750) and Matsumoto (U.S. 7,018,763).

At the outset, Applicants note that the present application claims the priority of Japanese Application JP 2003-79244 (JP

'244) filed on March 24, 2003. This Japanese filing date is prior to the May 20, 2003 U.S. filing date of Matsumoto. Applicants perfected the claim of priority by providing a certified English language translation of the Japanese priority application JP '244 along with the Response dated August 2, 2006. Furthermore, the claimed invention is supported by JP '244. Thus, Applicants respectfully submit that Matsumoto is no longer prior art.

Turning to Tan, Matsushima and Hagi, Applicants note that these prior art references do not teach a mold-releasing agent uniformly included in the toner particle.

As noted by the Examiner, Tan teaches an offset preventing agent (col. 11, lines 19-28), which is not the crystalline ester compound of the present invention. Thus, Tan fails to teach the crystalline ester compound as is claimed in claim 1.

The Examiner turned to Matsushima to cure the deficiencies of Tan. However, Matsushima does not teach the crystalline ester compound of the present invention. Matsushima teaches a crystalline ester compound located in the central portion (core) of the resin particles (col. 4, lines 41-50). In fact, Matsushima provides that the crystalline ester compound can be located anywhere other than the outermost layer (col. 3, lines 49-53). In contrast, the present invention provides that the

crystalline ester compound is uniformly included in the toner particles. Thus, Matsushima does not cure the deficiencies of Tan, and therefore does not teach or suggest the claimed method of the present invention.

With respect to Hagi, Hagi does not cure the deficiencies of Tan and Matsushima. Hagi does not teach the crystalline ester compound of the present invention. Thus, based on the teachings of Tan, Matsushima and Hagi, one of ordinary skill in the art would not arrive at the present Invention.

Since none of the references cited by the Examiner teach the crystalline ester compound uniformly included in the toner particle as claimed in claim 1, it is respectfully submitted that the claims presented herein are patentable over the cited references.

Double Patenting Rejection

Claim 1 has been provisionally rejected on the basis of non-statutory double patenting over claim 13 of Matsumoto (U.S. 7,018,763). Applicants respectfully submit that the claim 13 of Matsumoto is not the same as claim 1 of the present invention.

First, claim 13 of Matsumoto is directed to a product, specifically, a developing toner. In contrast, claim 1 of the present invention is directed to a method for producing a toner. Thus, claim 13 of Matsumoto fails to describe the steps of claim

1. Specifically, Matsumoto does not describe a coagulating step. Nor does Matsumoto describe that the coagulating step includes at least one crystalline ester compound represented by Formula 1 and resin particles in an aqueous medium in the presence of an aluminum compound. Thus, the claims are clearly not the same invention and are patentably distinct.

Furthermore, as discussed above, Matsumoto does not teach the crystalline ester compound of the present invention. Matsumoto requires that the crystalline ester compound can be located anywhere except the outermost layer. In contrast, the method as claimed in claim 1 of the present invention provides a crystalline ester compound that is uniformly located in the toner particle. Thus, the method of claim 1 provides a materially different toner than the toner of Matsumoto.

Thus, Applicants respectfully submit that claim 1 of the present invention is patentably distinct from claim 13 of Matsumoto and thus, the double patenting rejection should be withdrawn.

Request for One Month Extension of Time

Applicants hereby request a one month extension of time. The fee associated with this Extension is paid concurrent with the filing of this Response.


Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

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